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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848
25247 7590 01/09/2009 GORDON E NELSON PATENT ATTORNEY, PC 57 CENTRAL ST PO BOX 782 ROWLEY, MA 01969				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
NOTIFICATION DATE		DELIVERY MODE		
01/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

genelson@northshorepatents.com

# Office Action Summary

Application No.

09/730,299

Applicant(s)

FALCHUK ET AL.

Examiner

Natalie A. Pass

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 October 2008 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed 15 October 2008. Claims 1-4 have been amended. Claims 1-4 remain pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4 are rejected under 35 U.S.C. § 101.

A) As per claims 1-4, these appear to be directed toward a method or process of providing continuing medical education credit to a physician. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., an "accreditation report") is not a transformation because an accreditation report is not statutory subject matter. Thus, claims 1-4 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

5. The rejection of claims 1-4 under 35 U.S.C. 112, first paragraph for containing new matter is hereby withdrawn due to the amendment filed 15 October 2008.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing medical education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities', Proceedings of the National Forum 27-29 March 1995. URL:

<<http://ieeexplore.ieee.org/icl3/3745/10944/00504546.pdf?tp=&number=504546&isnumber=10944>>, hereinafter known as Fontelo, and further in view of Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information article, September 1995, URLs:

<<http://www.wwww.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and

<<http://www.wwww.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as Remote. Further reasons appear hereinbelow.

(A) As per claim 1 Fontelo a method of providing continuing medical education credit to a first physician for a consultation between the first physician and a second physician, the first

and second physicians being coupled to an intermediary via a telecommunications system, the method comprising the steps of:

receiving by the intermediary a request for a consultation from the first physician via the telecommunications system (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2, Figure 1, Figure 5);

receiving a selection by a staff physician of the second physician, the second physician having an expertise in a specialty in which the consultation is requested by the first physician (Fontelo; paragraph bridging page 141 column 2 and page 142, column 1);

sending by the intermediary the request to the selected second physician via the telecommunications system (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2, Figure 1, Figure 5);

receiving by the intermediary a comment made with regard to the consultation via the telecommunications system from the selected second physician (Fontelo; paragraph bridging page 141 column 2 and page 142, column 1); Examiner interprets Fontelo's teachings of "a forum for exchanging diagnostic opinions on ... [...] ... cases from other pathologists or diagnosticians ... [...] ... " to be a form of; "receiving by the intermediary a comment made with regard to the consultation via the telecommunications system from the selected second physician;"

providing the comment from the selected second physician to the first physician via the telecommunications system (Fontelo; page 141 column 2, paragraphs 2-3, page 142, column 1, paragraph 1 to page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figures 3-5);

notifying a continuing medical education accreditation module in the intermediary that the consultation has been successfully concluded (Fontelo; page 141 column 2, paragraphs 2-3, page 142, column 1, paragraph 1 to page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figures 3-5);

recording information concerning the consultation in a continuing medical education database, the information being associated with the first physician (Fontelo; paragraph bridging page 141 column 2 and page 142, page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figure 3, Figure 5); Examiner interprets archived images on the server that are “accessible to pathologists worldwide” to be a form of “recording information concerning the consultation in a continuing medical education database;” and

creating an accreditation report for the first physician from the information in the continuing medical education database, the accreditation report comprising a certification of the continuing medical education credit earned by the first physician (Fontelo; paragraph bridging page 141 column 2 and page 142, page 142, page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figure 3).

Fontelo fails to explicitly disclose continuing medical education credit earned from participation in the consultation.

However, the above features are well-known in the art, as evidenced by Remote.

In particular, Remote teaches

continuing medical education credit earned from participation in the consultation (Remote; page 168, column 1, paragraph 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Fontelo to include these limitations, as taught by Remote, with the motivations of not interrupting physicians' practices to achieve "(CME) requirements, which are necessary for license renewals," and instead to provide "educational activity [that] becomes directly relevant to their day-to-day practice and more meaningful than a lecture format."

(B) As per claim 2, Fontelo and Remote teach a method as analyzed and discussed in claim 1 above, wherein the method further comprises the steps of:

retrieving by the intermediary instructional material relevant to the comment and the consultation selected by the staff physician from the-an information data base (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2); and

providing the instructional material to the first physician via the telecommunications system (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2).

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing Medical Education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities.', Proceedings of the National Forum, 27-29 March 1995. URL:

<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&arnumber=504546&isnumber=10944>>, hereinafter known as Fontelo, and Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information



article, September 1995, URLs:

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as

Remote, as applied to claims 1 and 2 above, and further in view of Galewitz, P., Doctors Can

Now Get Continuing Education On-Line. Palm Beach Post. Jul 8, 1996. URL:

<<http://proquest.umi.com/pqdweb?did=66323909&sid=4&Fmt=3&clientId=19649&RQT=309&VName=PQD>>, hereinafter known as Galewitz.

(A) As per claims 3-4, Fontelo and Remote teach a method as analyzed and discussed in claims 1 and 2 above.

Fontelo and Remote fail to explicitly disclose wherein the method further comprises the steps of:

providing by the intermediary an examination based on at least the instructional material or the comment to the first physician via the telecommunications system;

receiving by the intermediary answers for the examination from the first physician via the telecommunications system; and

grading by the intermediary the received answers, the first physician being entitled to the medical education credit if the first physician passes the examination.

However, the above features are well-known in the art, as evidenced by Galewitz.

In particular, Galewitz teaches

providing by the intermediary an examination based on at least the instructional material or the comment to the first physician via the telecommunications system (Galewitz, page 1, paragraph 5-6);

receiving by the intermediary answers for the examination from the first physician via the telecommunications system (Galewitz, page 1, paragraph 5-6); and

grading by the intermediary the received answers, the first physician being entitled to the medical education credit if the first physician passes the examination (Galewitz, page 1, paragraph 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Fontelo and Remote to include these limitations, as taught by Galewitz, with the motivations of placing “having doctors take continuing education tests by computer” and placing “physicians ... [...] ... on the honor system” to ensure they have covered the course materials, and thereby enabling “a doctor ... [to] ... get continuing education credits at his own convenience” (Galewitz, page 1, paragraph 5-8).

### ***Response to Arguments***

9. Applicant’s arguments on pages 6-8 of the response filed 15 October 2008 have been fully considered but they are not persuasive. Applicant’s arguments will be addressed hereinbelow in the order in which they appear in the response 15 October 2008.

(A) Applicant arguments at pages 6-8 of the response filed 15 October 2008 are moot in view of the new ground(s) of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./  
Examiner, Art Unit 3686  
January 5, 2009

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686